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09/215,951	12/18/1998	JOSEPH P. FELL	659/489	1434

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BRINKS HOFER GILSON & LIONE
P.O. BOX 10395
CHICAGO, IL 60611

EXAMINER

CHEVALIER, ALICIA ANN

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Paper No. 30

Application Number: 09/215,951

Filing Date: December 18, 1998

Appellant(s): FELL ET AL.

MAILED

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GROUP 1700

Anastasia Heffner
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed July 2, 2003.

(1) *Real Party in Interest*

A statement identifying the real party in interest is contained in the brief.

(2) *Related Appeals and Interferences*

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) *Status of Claims*

The statement of the status of the claims contained in the brief is correct.

(4) *Status of Amendments After Final*

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) *Summary of Invention*

The summary of invention contained in the brief is correct.

(6) *Issues*

The appellant's statement of the issues in the brief is correct.

(7) *Grouping of Claims*

The appellant's statement of the claims stand or fall together is acknowledged.

(8) *ClaimsAppealed*

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) *Prior Art of Record*

5,843,066	DORBIN	12-1998
5,706,524	HERRIN et al.	01-1998
5,209,801	SMITH	05-1993
4,720,415	VANDER WIELEN et al.	01-1988
3,371,668	JOHNSON	05-1968

(10) *Grounds of Rejection*

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 102

1. Claims 1, 3, 5-9, 15, 17, 18, and 48-50 are rejected under 35 U.S.C. 102(b) as being anticipated by Johnson (3,371,668).

Johnson discloses a nonwoven liquid permeable cover (col. 4, lines 74-75) for a sanitary napkin comprising parallel elastic strands sandwiched between two webs of individualized fibers (col. 1, lines 10-13 and col. 4, lines 29-32). The cover is constructed by holding the parallel

strands of elastic under tension, sandwiching them between two webs of individualized fibers and then bonding the three layers with bond material in a wavy-line pattern. From figure 1 it can be seen that the wavy bond lines are approximately the same size and are spaced approximately equally apart from each other, which creates zones of attachment and unattachment.

After the composite cover is assembled the tension in the elastic stands is released, each of the strands relaxes and creates a multitude of buckles, which extend transversely to the longitudinal direction of the strands. See column 4, lines 29-46, and figures 1 and 2. In construction the elastic strands in the laminate have been tensioned sufficiently during manufacture to permit 100% extension of the finished fabric, i.e. after bonding of the sandwiched strands, which are extended to a little better than twice their original length; release of tension provides a buckled fabric which, in this instance, can be extended to twice its length (col. 4, lines 55-61).

The liquid permeable webs are constructed with a repeating pattern of voids (breathable) spanning the length and width of each web (col. 4, lines 47-49). The edges of the cover are overlapped and bonded (stiffened edge) in position along the non-body-contacting face of the napkin (col. 5, lines 30-33 and figure 4).

Claim Rejections - 35 USC § 102/103

2. Claims 1, 2, 4, 6-9, 15, 17, and 18 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Smith (5,209,801).

Smith discloses a disposable elastic structure for use as sweat bands, bandages, athletic supporters, support straps for incontinence devices and the like (col. 1, lines 26-29). The elastic

structure comprising a first outer breathable layer, a central layer of a multiplicity of nonintersecting elastic strands, and a second outside breathable layer joined together. The structure is achieved by forming a layer of nonintersecting elastic strands, tensioning the strands, positioning the tensioned stands between two layers of breathable material, joining the layers together, and releasing the tension in the strands and thereby permitting them to contract and draw the outer layers into pleats or shirrs. The nonintersecting elastic strands are typically configured so that they are slightly out of parallel and/or irregularly spaced and/or nonuniformly tensioned so as to cause the pleats to form slightly irregularly. See col. 2, lines 53-68. The breathable material layers are bonded to the nonintersecting elastic strand layer by adhesive, which is patterned (col. 5, lines 27-31 and figure 6) creating attached and unattached zones.

The nonintersecting elastic strands can either be a plurality of strands or a single strand made of Lycra (col. 3, lines 51-60 and figures 1 and 6).

The final structure is equipped with a closure (stiffened edge) at the edges (col. 6, lines 11-15). The resulting structure is both breathable and liquid permeable (col. 6, lines 15-16).

Although Smith does not explicitly teach the limitations the maximum elongation of the composite is at least about 95% of the elongation of an elastic member, it is reasonable to presume that said limitations are inherent to the invention. Support for said presumption is found in the use of similar materials (i.e. Lycra elastic strands sandwiched between breathable webs) and in the similar production steps (i.e. tensioning the elastic strands when bonding to the breathable webs) used to produce the elastic structure. The burden is upon the Applicant to prove otherwise. *In re Fitzgerald*, 205 USPQ 594. In the alternative, the claimed elongation would obviously have been provided by the process disclosed by Smith. Note *In re Best*, 195

USPQ 433, footnote 4 (CCPA 1977) as to the providing of this rejection under 35 USC 103 in addition to the rejection made above under 35 USC 102.

3. Claims 1, 3, and 5-18 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Herrin et al. (5,706,524).

Herrin discloses a disposable undergarment waistband comprising a first elongate layer of non-woven material, a plurality of elongate elastic strips, and a second elongate layer of non-woven material (col. 2, lines 59-67). An adhesive or glue preferably is positioned in a uniform pattern is used to secure the layers together, creating attached and unattached zones. See column 5, lines 36-54. The elastic strips are secured to the first and second elongate layer in stretched condition and gathers are formed in the first and second layer when the elastic strips are relaxed. The waistband further comprises hook and loop type fasteners at each respective edge. See column 6, lines 21-37.

The first and second layers are preferably non-woven fabric material, which can either be breathable or non-breathable. The fabric material preferably includes a plastic or polymeric material either formed integrally therewith or attached as a thin layer to the non-woven material to provide securing of the layers. See column 5, lines 54-60.

Although Herrin does not explicitly teach the limitations the maximum elongation of the composite is at least about 95% of the elongation of an elastic member, it is reasonable to presume that said limitations are inherent to the invention. Support for said presumption is found in the use of similar materials (i.e. elastic strands sandwiched between non-elastic webs) and in the similar production steps (i.e. tensioning the elastic strands when bonding to the non-elastic webs) used to produce the elastic structure. The burden is upon the Applicant to prove

otherwise. *In re Fitzgerald*, 205 USPQ 594. In the alternative, the claimed elongation would obviously have been provided by the process disclosed by Herrin. Note *In re Best*, 195 USPQ 433, footnote 4 (CCPA 1977) as to the providing of this rejection under 35 USC 103 in addition to the rejection made above under 35 USC 102.

Claim Rejections - 35 USC § 103

4. Claims 1, 2, 4, 6-9, 15, 17, and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Smith (5,209,801) in view of Vander Wielen et al. (4,720,415).
Smith does not explicitly teach the limitations the maximum elongation of the composite is at least about 95% of the elongation of an elastic member.

Vander Wielen discloses a composite elastomeric material comprising an elastic web held in tension sandwiched between two gatherable webs and bonded together. Gather form in the unbonded sections of the gatherable webs after the tension is released in the elastic web. See column 13, line 15 to column 14, line 68 and figure 2A.

Vander Wielen further discloses that the stretchable composite material elongation is dependent on the amount the elastic web is stretched, i.e. if it is desired to prepare a composite material stretchable to 100 percent elongation, a 100 cm length of elastic web may be stretched to a length of, for example 220 cm (120 percent elongation) and bonded at spaced-apart locations to a 220 cm length of non-elastic material. See column 9, lines 24-60.

If the maximum elongation is not inherent to Smith then, the exact maximum elongation of the composite is deemed to be a cause effective variable with regard elongation of the elastic member when bonded to the nonelastic webs. It would have been obvious to one having

ordinary skill in the art to have determined the optimum value of a cause effective variable such as maximum elongation of the composite, as similarly taught by Vander Wielen, through routine experimentation in the absence of a showing of criticality in the claimed maximum elongation.

In re Boesch, 205 USPQ 215 (CCPA 1980), *In re Woodruff*, 16 USPQ2d 1934, 1936 (Fed. Cir. 1990). It is desirable to have a high maximum elongation, such as 85% or higher, because the more the structure can elongate the longer the structure becomes in length and is capable of surrounding bigger items. This enables the elastic structure to fit a wider variety of shapes and sizes.

5. Claims 1, 3, and 5-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Herrin et al. (5,706,524) in view of Vander Wielen et al. (4,720,415).

Herrin does not explicitly teach the limitations the maximum elongation of the composite is at least about 95% of the elongation of an elastic member.

Vander Wielen discloses a composite elastomeric material comprising an elastic web held in tension sandwiched between two gatherable webs and bonded together. Gather form in the unbonded sections of the gatherable webs after the tension is released in the elastic web. See column 13, line 15 to column 14, line 68 and figure 2A.

Vander Wielen further discloses that the stretchable composite material elongation is dependent on the amount the elastic web is stretched, i.e. if it is desired to prepare a composite material stretchable to 100 percent elongation, a 100 cm length of elastic web may be stretched to a length of, for example 220 cm (120 percent elongation) and bonded at spaced-apart locations to a 220 cm length of non-elastic material. See column 9, lines 24-60.

If the maximum elongation is not inherent to Herrin then, the exact maximum elongation of the composite is deemed to be a cause effective variable with regard elongation of the elastic member when bonded to the nonelastic webs. It would have been obvious to one having ordinary skill in the art to have determined the optimum value of a cause effective variable such as maximum elongation of the composite, as similarly taught by Vander Wielen, through routine experimentation in the absence of a showing of criticality in the claimed maximum elongation.

In re Boesch, 205 USPQ 215 (CCPA 1980), *In re Woodruff*, 16 USPQ2d 1934, 1936 (Fed. Cir. 1990). It is desirable to have a high maximum elongation, such as 85% or higher, because the more the structure can elongate the longer the structure becomes in length and is capable of surrounding bigger items. This enables the elastic structure to fit a wider variety of shapes and sizes.

6. Claims 2 and 4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Johnson (3,371,668) or Herrin et al. (5,706,524) in view of Smith (5,209,801).

Both Johnson and Herrin disclose all the limitations of the instant claimed invention except for the elastic members are slightly out of parallel and the elastic members comprise a single strand.

Smith discloses a disposable elastic structure for use as sweat bands, bandages, athletic supporters, support straps for incontinence devices and the like (col. 1, lines 26-29). The elastic structure comprising a first outer breathable layer, a central layer of a multiplicity of nonintersecting elastic strands, and a second outside breathable layer joined together. The structure is achieved by forming a layer of nonintersecting elastic strands, tensioning the strands, positioning the tensioned stands between two layers of breathable material, joining the layers

together, and releasing the tension in the strands and thereby permitting them to contract and draw the outer layers into pleats or shirrs. The nonintersecting elastic strands are typically configured so that they are slightly out of parallel and/or irregularly spaced and/or nonuniformly tensioned so as to cause the pleats to form slightly irregularly. See col. 2, lines 53-68. The breathable material layers are bonded to the nonintersecting elastic strand layer by adhesive, which is patterned (col. 5, lines 27-31 and figure 6) creating attached and unattached zones.

The nonintersecting elastic strands can either be a plurality of strands or a single strand made of Lycra (col. 3, lines 51-60 and figures 1 and 6).

The final structure is equipped with a closure (stiffened edge) at the edges (col. 6, lines 11-15). The resulting structure is both breathable and liquid permeable (col. 6, lines 15-16).

It would have been obvious to one of ordinary skill in the art to make the elastic stands of either Johnson or Herrin slightly out of parallel and/or with one strand as taught by Smith because the effect of having the pleats form slightly irregularly reduces folds that can pinch skin or pull hairs.

7. Claims 10-14 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Johnson (3,371,668) in view of Dobrin (5,843,066).

Johnson discloses all the limitations of the instant claimed invention except for the first or second layer comprising non-breathable or water impervious material.

Dobrin discloses that it is known that the disposable absorbent articles can be covered with a flexible, liquid and vapor impervious sheet to prevent any absorbed liquid from passing through and soiling adjacent articles such as clothing. See column 1, lines 17-21.

It would have been obvious to one of ordinary skill in the art at the time of the invention to use a liquid or vapor impervious sheet as either the first or second layer in Johnson for the side not adjacent the body because it would prevent liquid from passing through and soiling adjacent articles such as clothing.

(11) *Response to Argument*

Appellant's arguments all center on the limitation "the stretchable composite material having a maximum elongation of at least about 85% of the elongation of the elastic member" in claim 1 and claim 48. Appellant argues that the Examiner has misunderstood and ignored this limitation. Specifically, Appellant argues that the composite materials of the instant invention allow for a greater use of the elongation of one or more of the elastic members *initially* incorporated into the composite material (the *initial* elongation), to produce composite materials that have a maximum elongation that is at least about 85% of the *initial* elongation of one or more of the elastic members located between the first and the second layers of the composite material (See Appellant's Brief page 7, last paragraph to page 8, first paragraph).

First and for most, as reiterated from the previous office action, the limitation "the initial elongation of the elastic members" is not in the claims. It is the claims that define the claimed invention, and it is claims, not specifications that are anticipated or unpatentable.

Second, Appellant seems to have misinterpreted the principle that the claims are interpreted in light of the specification. Although Appellant shows that the elongation of the elastic member was the initial elongation in the example on page 6, line 27 to page 7, line 10 in the specification, it was not claimed explicitly. Nor were the was the phrase "elongation of the

elastic member” that is used in the claims defined in the specification to require it to be the initial elongation of the elastic member when the first and second layers are secured to the elastic member. A reading of the specification provides no evidence to indicate that “the elongation of the elastic member” be the initial elongation of the elastic members when the composite is made must be imported into the claims to give meaning to the limitation.

MPEP 2111 and 2111.01 states:

During patent examination, the pending claims must be “given *their* broadest reasonable interpretation consistent with the specification.” *In re Hyatt*, 211 F.3d 1367, 1372, 54 USPQ2d 1664, 1667 (Fed. Cir. 2000). Applicant always has the opportunity to amend the claims during prosecution, and broad interpretation by the examiner reduces the possibility that the claim, once issued, will be interpreted more broadly than is justified. *In re Prater*, 415 F.2d 1393, 1404-05, 162 USPQ 541, 550-51 (CCPA 1969).

While the claims of issued patents are interpreted in light of the specification, prosecution history, prior art and other claims, this is not the mode of claim interpretation to be applied during examination. During examination, the claims must be interpreted as broadly as their terms reasonably allow. This means that the words of the claim must be given their plain meaning unless applicant has provided a clear definition in the specification. *In re Zletz*, 893 F.2d 319, 321, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989); *MSM Investments Co. v. Carolwood Corp.*, 259 F.3d 1335, 1339-40, 59 USPQ2d 1856, 1859-60 (Fed. Cir. 2001).

As discussed above Appellant has not defined that the elongation of the elastic member of the limitation “the stretchable composite material having a maximum elongation of at least about 85% of the elongation of the elastic member” is the initial elongation of the elastic member when the elastic members are secured to the first and second layer in the instant specification. Therefore, the elongation of the elastic member has been given its broadest reasonable interpretation and plain meaning of any elongation of the elastic member.

In view of the Examiner’s broadest reasonable interpretation of the limitation “the stretchable composite material having a maximum elongation of at least about 85% of the

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elongation of the elastic member" the prior art of record still teaches each and every limitations.

Furthermore, Appellant's specific arguments about the prior art are moot in view of the interpretation of the limitation.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

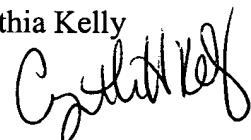


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September 5, 2003

Conferees 
Harold Pyon

Cynthia Kelly



GLEN P BELVIS
BRINKS HOFER GILSON & LIONE
P O BOX 10395
CHICAGO, IL 60610